

Application. No.: 10/798,595
Docket No.: FDN-2795
AMENDMENT

Remarks/Arguments:

Claims 1-31 remain in this application. Claims 2-4, 6, 7, 19-21, 23 and 24 have been withdrawn. Claims 1, 5, 8-18, 22, 25-31 stand rejected. Review and reconsideration of this application on the merits are respectfully requested in view of the foregoing amendments and the following discussion.

Claims 1, 8, 10, 12, 13, 15 and 25 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,544,909. According to the Office Action, these claims are substantially similar to claim 1 of the '909 patent. Applicants traverse this rejection for the following reasons. The Office has failed to establish a *prima facie* case of obviousness with respect to these claims. The Office has failed to carry its burden of showing why the claims are obvious over claim 1 of the '909 patent. Arguing that the claims are substantially similar to claim 1 of the '909 patent is insufficient to show that these claims are obvious.

Claim 1 of the '909 patent describes a single-ply reinforced roofing membrane having a reinforcement scrim sandwiched between two layers made of ethylene-butene copolymers wherein at least one of the layers includes a certain amount of maleic anhydride-modified polypropylene as an additive. The '909 patent fails to disclose or suggest a mechanically embossed single-ply roofing membrane wherein the bottom layer is mechanically embossed forming an embossment of alternating ridges and valleys as set forth in the claims of the pending application. The Office has failed to identify this limitation in the '909 reference or provide a motivation for modifying the '909 patent to obtain the claimed roofing membranes. Accordingly, applicants respectfully submit that the claims of the present application are novel and non-obvious over the '909 patent and request that the rejection be withdrawn.

Claims 1, 5, 8-12, 14-18, 25, 26, 28, 30 and 31 stand rejected as being unpatentable over U.S. Patent No. 6,134,856 to Khan et al. Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to the rejected claims.

Factors to be evaluated in determining obviousness include “the scope and content of the prior art...differences between the prior art and claims at issue...and the level of ordinary skill in the pertinent art.” *Graham v. John Deere Co.* , 383 U.S. 1 (1966). “A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l. v. Teleflex Inc.*, 127 S. Ct. 1727, 1731 (2007). However, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 1741. A finding of obviousness must be based on more than “mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id. quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). All claim limitations must be identified in the cited references to establish a *prima facie* case of obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006).

Applicants submit that one of ordinary skill in the art would not have been motivated to modify the roll roof membrane of Khan such that the embossed selvage edges extend over a majority of the surface area of the bottom layer. The Office Action simply indicates that it would have been obvious to increase the area of ridges and valleys “since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art.” However, this conclusory statement fails to adequately address the issue of motivation to modify the Khan reference as suggested in the Office Action. Extending the embossed edges over a majority of the surface area of the bottom layer of the roll roof membrane has nothing to do with duplication of essential working parts of a device. The embossed ridges and valleys in the selvage edges are adapted to accept adhesives thereby improving bonding between the overlap portions of the membranes. Furthermore, the embossed ridges and valleys are provided along a first selvage edge disposed in the top of the membrane and along a second selvage edge disposed in the bottom of the membrane. Modifying the Khan structure to relocate all of the ridges and valleys to the bottom of the membrane and have the ridges and valley extend over a majority of the surface area of the bottom layer would destroy the disclosed benefits associated with the

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Khan structure. One of ordinary skill in the art would never consider extending the ridges and valleys across a majority of the surface area of the bottom layer because the purpose of the ridges and valleys is to provide improved bonding along the edges of the membrane. Applicants respectfully submit that the purported motivation set forth by the Office is insufficient to suggest modifying the Khan membrane to include embossment over a majority of the surface layer of the bottom layer. Accordingly, the Office has failed to articulate “reasoning with some rational underpinning to support the legal conclusion of obviousness.” Therefore, applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness and request that the rejection under 35 U.S.C. §103 be withdrawn.

The remaining claims stand rejected as being unpatentable over Khan in combination with various secondary references. These claims are patentable for the same reasons as set forth above since the cited secondary references fail to remedy the shortcomings of the Khan reference. Accordingly, applicants respectfully submit that the claims of the present application are novel and non-obvious over the cited references and request that the rejections be withdrawn.

In view of the foregoing, it is respectfully submitted that all of the pending claims are in condition for allowance and favorable action on the merits is requested. In the event that the Examiner wishes to discuss any aspect of this response, please contact William J. Davis at (973) 628-3529 or the undersigned at the telephone number indicated below. We hereby authorize the Commissioner under 37 C.F.R. § 1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted:

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